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In re Application of :
Hawkins et al. :
Application No.: 10/524,446 : DECISION
PCT No.: PCT/US03/03605 :
Int. Filing Date: 07 February 2003 : ON
Priority Date: 07 February 2003 :
Attorney Docket No.: AQU1.PAU.01 : PETITION
For: Irrigation Connectors :

This is in response to the petition under 37 CFR 1.47(a) filed on 08 August 2005.

BACKGROUND

This international application was filed on 07 February 2003, and claimed no earlier priority date. The 30 month time period for paying the basic national fee in the United States expired at midnight on 08 August 2005 (since 07 August 2005 was a Sunday). Applicants filed *inter alia* the basic national fee on 11 February 2005.

On 06 June 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration in compliance with 37 CFR 1.497(a) and (b).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), petitioner paid \$130.00 toward the petition fee on 08 August 2005. The remaining \$70.00 is being charged to counsel's Deposit Account No. 01-1960, as authorized by the petition.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Wayne Miyasato be excused because he "refuses to sign in an application for patent or cannot be found or reached after diligent effort." With regard to the issue of whether Mr. Miyasato could be found or reached after diligent effort, it is noted that the petition and supporting documents identify two addresses for him, along with "a phone number to which a fax machine was connected." These facts do not suggest that Mr. Miyasato's whereabouts are uncertain within the meaning of 37 CFR 1.47(a), since efforts could readily be made to communicate with him at each of these three venues. It is noted that petitioner refers to "additional addresses" in Torrance, California, but does not recount any efforts undertaken to contact him at more than one Torrance address. The petition also alludes to a "skip trace search" but no documentation of that search or other efforts (such as internet searches or telephone

directory searches) has been provided. For these reasons, it would be inappropriate to conclude that Mr. Miyasato "could not be found or reached after diligent effort" at this time.

Regarding the issue of whether Mr. Miyasato has refused to execute the application, Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Counsel states that "an inventor's declaration" was sent to "the fax number listed" and to "each of the additional addresses found in the skip trace," but does not indicate whether correspondence was sent to his last known address, identified by petitioner as a certain address in Anaheim. Moreover, petitioner neither explicitly states that the "inventor's declaration" sent to him was directed to this particular application, nor that a complete copy of this specific application (including specification, claims and drawings) has been sent to him. As such, it would not be appropriate to interpret Mr. Miyasato's failure to return an executed declaration as a refusal to execute within the meaning of 37 CFR 1.47(a) on the basis of the evidence presented.

Regarding requirement (3), the petition includes a statement the last known address of Wayne Miyasato. Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), the petition is accompanied by a declaration document signed by joint inventors Stanley Hawkins and James Matlock, as well as by a second declaration document signed by none of the inventors, but signed by "David Abrams, President of Aquarius Brands, Inc., Assignee, on Behalf of Inventor Wayne M. Miyasato." Counsel's attention is drawn to 37 CFR 1.47(a), which states in part that

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor.

This is to be distinguished from 37 CFR 1.47(b), which states in part that

Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors.

The declaration signed by Mr. Abrams is defective because he purports to sign for an assignee on behalf of the non-signing inventor, which is appropriate under 37 CFR 1.47(b) but not under 37 CFR 1.47(a). Since this petition was brought under 37 CFR 1.47(a), Mr. Abrams' signature is inappropriate. Moreover, since Mr. Abrams has signed a declaration "on behalf of" the nonsigning inventor, it becomes unclear whether joint inventors Hawkins and Matlock signed the declaration on behalf of Miyasato as well. Therefore, neither of the declaration documents filed on 08 August 2005 are acceptable.

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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